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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,973	11/13/2003	Hemant M. Chaskar	061715-0381	6783
30542 7590 06/25/2009 FOLEY & LARDNER LLP P.O. BOX 80278 SAN DIEGO, CA 92138-0278			EXAMINER HUYNH, CHUCK	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 06/25/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/705,973

**Applicant(s)**

CHASKAR ET AL.

**Examiner**

CHUCK HUYNH

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 60-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-71 is/are rejected.
- 7) ☒ Claim(s) 60, 65, 70, 71 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/07/2009 has been entered.

### ***Response to Amendment***

Claims 1-59 are cancelled.

Claims 60-71 are new.

### ***Response to Arguments***

Applicant's arguments with respect to claims 60-71 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

Regarding independent claims 60, 65, 70, 71, they include various if-statements within numerous limitations. The "if" limitations are not required for the system to be fully functional, and therefore, could have been excluded from examination. For example, the

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system would still be functional if the border information does not indicate the mobile being in non-border region and the sign strength is above a threshold; the system would still perform the first 2 limitations within the claim even when the if-statements don't hold true.

However, to further expedite the case Examiner has interpreted the if-statements to be wherein-statements. Correction is advised to amend If-statements to wherein-statements.

Furthermore, regarding claim 60, Examiner would urge Applicant to be specific to what apparatus is performing the various operations. For example, the first limitation of detecting border information does not necessitate the mobile node performing the detection; however, Examiner has assumed that the mobile node is performing the operation. Clarification is required.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims are 60, 64, 65, 69, 70, 71, rejected under 35 U.S.C. 102(b) as being anticipated by McNair et al. (NPL provided by Applicant in IDS: “An Inter-System Handoff Technique for the IMT-2000 System”; hereinafter McNair).**

Regarding claims 60, 65, 70, and 71, McNair discloses a method (handover operation: Col. 1, lines 35-47), comprising

detecting border information in a beacon of a first signal received from an access node with which a mobile node is connected (Page 210 Section A, Left Column: "When the MT approaches the intersystem boundary cells of network 1, the MT can hear beacons from network 1 base stations as well as network 1 boundary cell base station)

detecting a signal strength from a second signal received from the access node with which the mobile node is connected (Page 211, Left Column: "the MT...able to measure and compare signal strength for the surrounding base stations for both system; can be part of handoff into a boundary cell as discussed in section A);

**if** the border information indicates that the mobile node is in a non-border-region (non-overlapping network region: Fig. 2), (Section A: MT being able to measure and compare signal strength of both networks: Page 210, right column, lines 19-22) and **if** the signal strength is below a predetermined threshold (inherent in a handover detecting low signal power from current network handing over to another network), waiting for a predefined time (Section B: the time that the MT remains in ready state until handoff to network 2 is necessary: Page 210, right column, lines 40-44; furthermore the predefined time is also correlated with the minimum residency time requirement for the MT that must perform a format transformation within the boundary cell for successful inter-system handoff to network 2: Page 211, Section IV Performance Evaluation, first sentence) ; and

after the predefined time has passed, detecting a signal strength from a third signal received from the access node with which the mobile node is connected; and if the signal strength is still below a predetermined threshold, initiating handoff from a first technology network to a second technology network (Section C: MT measuring and comparing signal strength for handing off to network 2).

Regarding claims 64 and 69, McNair discloses the method of claim 60, wherein the second signal comprises either the first signal or another signal (Page 210, right column, lines 19-22).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 61, 62, 67, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNair in view of Lobinger et al. (US 7039409; hereinafter Lobinger).**

Regarding claim 61, McNair discloses all the particulars of the claim but is unclear about the method of claim 60, wherein the border information is provided as a border bit.

Even though it is known in the art that border cell identifier are represented by bits and then are broadcasted in beacons. Lobinger does disclose the limitation wherein the border information comprises a border bit in the beacons, wherein the border bit indicates whether an access point is placed at a border of the first technology network, and the detector is configured to detect the border bit (border cell identifiers--in bits--used for informing mobile stations (Col 6, lines 21-36).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate Lobinger's disclosure to provide representation of identifier for base stations.

Regarding claim 62, it would be a design choice according to Lobinger to decide which bit to denote bordering cell, and therefore it would have been obvious to one ordinarily skilled in the art to disclose the method of claim 61, wherein if the border bit is equal to 1, the mobile node is in a border-region of an area of the first technology network, and if the border bit is equal to 0, the mobile node is in a non-border-region of the area of the first technology network.

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate Lobinger's disclosure to provide representation of identifier for base stations.

**4. Claims 63 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNair in view of Reynolds (US 7149524).**

Regarding claim 63, McNair discloses all the particulars of the claim, but is unclear about the method of claim 60, wherein the first technology network comprises a wireless local access network.

However, Reynolds does disclose handovers including a wireless local access network (WLAN: Col 1, lines 42-46).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate Reynolds' disclosure to improve inter-system handovers with various networks.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUCK HUYNH whose telephone number is (571)272-7866. The examiner can normally be reached on M-F 1pm-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chuck Huynh/  
Examiner, Art Unit 2617

/Patrick N. Edouard/  
Supervisory Patent Examiner, Art Unit 2617